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| 10/582,360  | 06/09/2006  | Akihiko Sugiyama     | 040447-0283         | 1660             |
| 23428 7590 07/28/2008<br>FOLEY AND LARDNER LLP<br>SUITE 500<br>3000 K STREET NW<br>WASHINGTON, DC 20007 |             |                      |                     |                  |
| EXAMINER<br>BORSETTI, GREG  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/582,360

**Applicant(s)**

SUGIYAMA ET AL.

**Examiner**

GREG A. BORSETTI

**Art Unit**

2626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-59 is/are pending in the application.
- 4a) Of the above claim(s) 53-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
- Paper No(s)/Mail Date 12/14/2007, 6/9/2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 31-52 are pending.

#### ***Information Disclosure Statement***

2. The Information Disclosure Statements (IDS's) submitted on 12/14/2007 and 6/9/2006 are in compliance with the provisions of 37 CFR 1.97.

#### ***Drawings***

3. The drawings filed on 6/9/2006 are accepted by the examiner.

#### ***Election/Restrictions***

4. Applicant's election without traverse of Claims 31-52 in the reply filed on 6/11/2008 is acknowledged.
5. Claims 53-59 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/11/2008.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 38 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. It is not completely understood what is meant by the phrase "wherein the action of a target for which the voice is reproduced is promoted..." because there is no description of promotion of the reproduction in the specification. It is interpreted by the examiner that the action is enhanced by the addition information in conjunction with the voice reproduction. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 47-48 of the claimed invention are directed to non-statutory subject matter. The claims explicitly state that they are directed to a computer program which is nonstatutory under 35 USC 101 because it does not fall within one of the statutory categories.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 32-35, 38, 40-43, 46, 48, 50, and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Gabai et al. (US Patent #6773344 hereinafter Gabai).

As per claim 40, Gabai discloses the information processing system comprising:

information changing means for receiving inputted text and adding information which is not contained in the inputted text (Gabai, column 43, lines 3-19,

*...It is preferred, in such cases, that a toy not merely translate but combine its translations with other types of content that is appropriate to the given situation...*)

means for converting the output of the information changing means to voice (Gabai, column 20, lines 14-36, *...transfer information to the user through sound (possibly using text-to-speech technology)...*)

wherein the voice with the added information is reproduced (Gabai, column 53, lines 26-36, *...Their response includes, but is not limited to sound (including voice)...*)

As per claim 41, claim 39 or 40 is incorporated and Gabai further discloses:

The means for converting inputted text to voice is interpretation means (Gabai, column 43, lines 3-19, *...It is preferred, in such cases, that a toy not merely translate but combine its translations with other types of content that is appropriate to the given situation...*) Also, (Gabai, Figs. 58D)

As per claim 42, claim 39 or 40 is incorporated and Gabai further discloses:

Analysis means for getting analysis result by analyzing the text  
(Gabai, Figs. 58A-B, column 43, lines 20-21, ...*translates texts in a local or ancient language for its user/s...*) If the text is translated, it is inherently understood and has thus been analyzed.

Additional-information determining means for determining the adding information on the basis of the analysis result (Gabai, column 43, lines 44-50, ...*translating an ancient inscription a toy offers its user a historical commentary on the period and the occasion on which it was written and the subjects it concerns...*) The historical commentary is additional information based on the analysis result.

As per claim 43, claim 39 or 40 is incorporated and Gabai further discloses:

Analysis means for getting analysis result by analyzing the text  
(Gabai, Figs. 58A-B, column 43, lines 20-21, ...*translates texts in a local or ancient language for its user/s...*) If the text is translated, it is inherently understood and has thus been analyzed.

Additional-information-amount determining means for determining amount of the adding information on the basis of the analysis result (Gabai, column 43, lines 44-50, ...*translating an ancient inscription a toy offers its user a historical commentary on the period and the occasion on which it was written and the subjects it concerns...*) There is inherently a determined amount of available additional information because the database stores available additional information in the database that is retrieved based upon the analysis.

As per claim 46, claim 39 or 40 is incorporated and Gabai further discloses:

The action of a target for which the voice is reproduced is promoted, by the adding information (Gabai, Fig. 58D) Fig. 58D shows a translation process that adds information about the locals for which the translation is performing. The action of the user is enhanced by this additional information because it alerts the user that the locals are part of a "group in conflict with the local government," so the user can avoid them.

Claims 32, 48, 50, and 52 are rejected for the same reasons as claim 40 for having parallel limitations. Claim 32 is the method claim, where the method has been shown to be operable in an apparatus according to claim 40. Claim 48 is the program claim, where the apparatus as shown in claim 40 has been shown to be a computer based apparatus which inherently has to be programmed. Claims 50 and 52 are terminal and server claims where Gabai teaches that the toy can use cellular technology which is well known in the art to be able to independently process input as well as process the input through a server.

Claims 33-35, and 38 are rejected for the same reasons as claims 41-43, and 46, respectively. Claims 33-35, and 38 are the method claims, where the methods has been shown to be operable in the apparatus according to claims 41-43, and 46.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 31, 39, 47, 49, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabai et al. (US Patent #6773344 hereinafter Gabai) in view of Coorman et al. (US Patent #6665641 hereinafter Coorman)

As per claim 39, Gabai discloses the information processing system comprising:

means for converting inputted text to voice (Gabai, column 20, lines 14-36, ...*transfer information to the user through sound (possibly using text-to-speech technology)*...)

information changing means for adding information which is not contained in the inputted text, to the voice (Gabai, Figs. 58A-D, column 43, lines 3-19, ...*It is preferred, in such cases, that a toy not merely translate but combine its translations with other types of content that is appropriate to the given situation...*)

wherein the voice with the added information is reproduced (Gabai, column 53, lines 26-36, ...*Their response includes, but is not limited to sound (including voice)*...)



Gabai fails to teach, but Coorman teaches:

voice synthesis based on concatenation (Coorman, abstract, ...  
*concatenates speech waveforms referenced by a large speech database...*) The  
abstract teaches that prerecorded audio samples are taken from a database to  
construct the synthesis.

It would have been obvious to someone of ordinary skill in the art to combine the  
Coorman device with the Gabai device because the synthesis of Coorman could have  
been substituted into the Gabai device to synthesize the speech and would have given  
predictable results. Fig. 58D of Gabai shows that the toy checks a database record for  
relevant information. The Coorman database could have been used to generate the  
additional subsequent speech ("This dialect...") for the user.

Claims 31, 47, 49, and 51 are rejected for the same reasons as claim 39 for  
having parallel limitations. Claim 31 is the method claim, where the method has been  
shown to be operable in an apparatus according to claim 39. Claim 47 is the program  
claim, where the apparatus as shown in claim 39 has been shown to be a computer  
based apparatus which inherently has to be programmed. Claims 49 and 51 are  
terminal and server claims where Gabai teaches that the toy can use cellular technology  
which is well known in the art to be able to independently process input as well as  
process the input through a server.

10. Claims 36 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabai et al. (US Patent #6773344 hereinafter Gabai) in view of Kojima et al. (US Patent #5758318 hereinafter Kojima)

As per claim 44, claim 39 or 40 is incorporated and Gabai further teaches:

The adding of information based on the text analysis result (Gabai, column 43, lines 44-50, *...translating an ancient inscription a toy offers its user a historical commentary on the period and the occasion on which it was written and the subjects it concerns...*) The historical commentary is additional information based on the analysis result.

Gabai fails to teach, but Kojima teaches:

reproduce-time determining means for determining time length for reproducing the information on the basis of the analysis results (Kojima, column 1, lines 30-52, *...the delay time may be variably set depending on the time, the number of times the apparatus is used, the length of the speech interval, the speech power, the setting made by the user and the like...*) Furthermore, (Kojima, column 4, lines 17-23, *...Normally, it takes more time to understand the contents of the speech as the speech interval becomes longer...*) Kojima delays the information based on the analysis result.

It would have been obvious to someone of ordinary skill in the art at the time of the invention to combine Kojima with the Gabai device because "it is possible to prevent the user from becoming confused or uncomfortable by the output which is made too

quickly in a case where the speech recognition speed is too fast" (Kojima, column 1, lines 30-52) The combination of Kojima with the Gabai device would have been obvious to try because it improves human/machine interaction and has a reasonable expectation of success.

Claim 36 is rejected for the same reasons as claim 44. Claim 36 is the method claim, where the method has been shown to be operable in the apparatus according to claim 44.

11. Claims 37 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabai et al. (US Patent #6773344 hereinafter Gabai) in view of Uwakubo. (US Patent #6513011)

As per claim 45, claim 39 or 40 is incorporated and Gabai further teaches:

The adding of information based on the text analysis result (Gabai, column 43, lines 44-50, ...*translating an ancient inscription a toy offers its user a historical commentary on the period and the occasion on which it was written and the subjects it concerns...*) The historical commentary is additional information based on the analysis result.

Gabai fails to teach, but Uwakubo teaches:

Reaction-time analyzing means for analyzing reaction time of a target for which the voice is reproduced (Uwakubo, columns 7-8, lines 63-67 and 1-8, ...*a time period is clocked in some times, from a time when a reaction is presented to the output unit 360 (to the user) to another time when the user starts action in response to the presented reaction...*)

information determining means for determining the information on the basis of the analysis result (Uwakubo, column 8, lines 21-31, ... generate reactions or suspends the generating of the reactions, based on instructions from the conversation manage unit 330...) A reaction is generated based upon the reaction time of the user.

It would have been obvious to someone of ordinary skill in the art at the time of the invention to combine Uwakubo with the Gabai device because "prior devices can not follow changes of a length of a pause (timing) in a conversation" (Uwakubo, column 1, lines 38-42) The combination of Uwakubo with the Gabai device would have been obvious to try because it improves smooth information transition and has a reasonable expectation of success.

Claim 37 is rejected for the same reasons as claim 45. Claim 37 is the method claim, where the method has been shown to be operable in the apparatus according to claim 45.

### **Conclusion**

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to PTO-892, Notice of References Cited for a listing of analogous art.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREG A. BORSETTI whose telephone number is (571)270-3885. The examiner can normally be reached on Monday - Thursday (8am - 5pm Eastern Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHEMOND DORVIL can be reached on 571-272-7602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg A. Borsetti/  
Examiner, Art Unit 2626

Art Unit: 2626

/Talivaldis Ivars Smits/  
Primary Examiner, Art Unit 2626

7/22/2008